Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JOHN H. KUSMISS

Appeal No. 2001-1661
Application No. 09/144,654

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, STAAB and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 22 to 33, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to an apparatus for practicing a ball-propelling sport using a ball-returning device in conjunction with an imaging device (title). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hogue	3,711,092	Jan. 16, 1973
Pearson	3,996,711	Dec. 14, 1976
Pfeilsticker	4,333,646	June 8, 1982
Scheie	4,334,681	June 15, 1982
Newland et al. (Newland)	4,657,250	Apr. 14, 1987
Light	5,603,617	Feb. 18, 1997

Claims 22 to 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pfeilsticker in view of Pearson and Hogue.

Claims 25 to 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Light in view of Newland and Hogue.[1]

[1] In the answer (p. 4), the examiner inadvertently included claim 33 in this ground of rejection. However, the final rejection (p. 4) makes clear that only clams 25 to 32 are rejected on this basis.

Claim 33 stands rejected under 35 U.S.C. § 103 as being unpatentable over Scheie in view of Pfeilsticker.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 9, mailed October 12, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 8, filed July 17, 2000) and reply brief (Paper No. 10, filed December 12, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 22 to 33 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claims 22 to 24

We will not sustain the rejection of claims 22 to 24 under 35 U.S.C. § 103.

In the rejection of claims 22 to 24 the examiner determined (answer, pp. 3-4) that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to (1) employ the glass wall of Pearson in front of the tennis practice and training aid of Pfeilsticker in order to protect the mirror part of the tennis practice and training aid of Pfeilsticker from damage, and (2) employ the ball rebounding net of Hogue in front of the tennis practice and training aid of Pfeilsticker in order to protect the mirror part of the tennis practice and training aid of Pfeilsticker from damage.

The appellant argues that there is no motivation, suggestion or teaching to have combined the applied prior art in the manner set forth by the examiner. We agree.

In our view, one skilled in the art would not employ either the glass wall of Pearson or the ball rebounding net of Hogue in front of the tennis practice and training aid of Pfeilsticker in order to protect the mirror part of the tennis practice and training aid of Pfeilsticker from damage since Pfeilsticker teaches that the mirror part is made to withstand the impact of a tennis ball and a glass wall positioned to protect the mirror part would interfere with the intended use of the tennis practice and training aid of Pfeilsticker (i.e., a player hitting tennis balls against the tennis practice and training aid of Pfeilsticker). Thus, it is our opinion that the only suggestion for modifying the tennis practice and training aid of Pfeilsticker in the manner proposed by the examiner to arrive at the claimed invention stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that the decision of the examiner to reject claims 22 to 24 under 35 U.S.C. § 103 is reversed.

Claim 33

We will not sustain the rejection of claim 33 under 35 U.S.C. § 103.

In the rejection of claim 33 the examiner determined (answer, p. 5) that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have employed the mirrored practice and training aid of Pfeilsticker over the wall-mounted game board shown in Figures 7-8 of Scheie in order to better hold the attention of the player during practice and improve the realism of the practice.

The appellant argues that there is no motivation, suggestion or teaching to have combined the applied prior art in the manner set forth by the examiner. We agree.

Once again it is our view that the only suggestion for combining the applied prior art in the manner proposed by the examiner stems from hindsight knowledge derived from the appellants' own disclosure. Simply put, there is no motivation, suggestion or teaching in the combined teachings of Scheie and Pfeilsticker to have employed the mirrored practice and training aid of Pfeilsticker over the wall-mounted game board shown in Figures 7-8 of Scheie. It follows that the decision of the examiner to reject claim 33 under 35 U.S.C. § 103 is reversed.

Claims 25 to 32

We will not sustain the rejection of claims 25 to 32 under 35 U.S.C. § 103.

In the rejection of claims 25 to 32 the examiner determined (answer, pp. 4-5 and 7) that the claimed "practice backboard for returning balls hit against said backboard" was readable on Light's sports trainer 10 since mirror 38 has a sufficiently large mass to return a tennis ball when it is hit. The appellant disagrees.

We find ourselves in agreement with the appellant on this issue. While clearly the mirror 38 of Light's sports trainer 10 would stop a tennis ball, it is our view that there is insufficient evidence to establish that the mirror 38 is inherently capable of returning a tennis ball hit against the mirror to the player to enable that player to practice as set forth in claims 25 to 32. Thus, even if the video camera of Newland were added to Light's sports trainer 10 it would not arrive at the claimed invention.

Since the subject matter of claims 25 to 32 is not suggested by the applied prior art for the reasons set forth above, the decision of the examiner to reject claims 25 to 32 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 22 to 33 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH Senior Administrative Patent Judge	))
LAWRENCE J. STAAB Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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